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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/282,764 03/31/99 PONTE

J GTE-99-808

EXAMINER

TM02/0828

LEONARD CHARLES SUCHYTA
GTE SERVICE CORPORATION
600 HIDDEN RIDGE ROAD
MAILCODE HQE03H01
IRVING TX 75038

CHAMPAGNE, D

ART UNIT

PAPER NUMBER

2162

DATE MAILED:

08/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/282,764

Applicant(s)

PONTE ET AL

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-12, 15-21, 24 and 25 is/are rejected.
- 7) ☒ Claim(s) 13, 14, 22 and 23 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102 and 35 USC § 103

1. The following is a quotation of the appropriate paragraphs of 35 USC 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. The following is a quotation of 35 USC 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 6, 7, 9-12, 15, 16, 18-21, 24 and 25 are rejected under 35 USC 102(e) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Alberts.
4. Alberts teaches a method for targeting advertisements, and a computer program product and apparatus for displaying advertisements, comprising: associating at least one category (e.g., *skiing*, col. 7 lines 24-25) with documents that may be retrieved (a list of "ski manufacturers", etc.), said category including at least one term (also "skiing", col. 7 line 26); associating an advertisement with the at least one category (col. 3 lines 46-47 and col. 7 lines 8-9); determining at least one term associated with a data query (col. 3 line 12 and col. 7 line 26); determining a category based on at least one term (col. 7 lines 25-27); and displaying an advertisement associated with said category (col. 3 lines 47-48).
5. Alberts does not teach (claims 6, 15 and 24) associating at least one supercategory with multiple categories. However, since Alberts teaches the method claimed, under the principles of inherency (MPEP § 2112.02) the invention is considered to be anticipated in this regard by Alberts. As evidence tending to show inherency, it is noted first that Alberts does teach a "supercategory", a geographic area (*particular region*, col. 7 line 12), that is also taught by the instant application (claim 12). The example supercategory (a geographic

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area) and multiple categories taught by the reference, photography and skiing (col. 7 lines 17 and 18), are inherently associated, because, for example, the mountains outside Salt Lake City suggest both activities.

6. Alberts also does not teach associating an advertisement with at least one supercategory. However, this also is inherent because the reference does teach associating the ad with a category, and the category is inherently associated with the supercategory (i.e., if A is associated with C and C is associated with S, then A is inherently associated with S).
7. Alberts also does not teach (claims 7, 16 and 25) ranking to determine the most important category/supercategory. However, this also is inherent: "ranking" is taken to mean "ordering by importance", so an ordering by importance is inherently done to determine the most important. Alternately, the reference does teach ranking (i.e. ordering in a table) of categories, and it would be obvious to use the order most beneficial to the task, which reads on "most important".
8. Alberts also teaches (claim 10) "Table 30" (col. 3 lines 46-47), including "triggering information/event", which reads on terms occurring in the data query and categories.
9. Claims 8 and 17 are rejected under 35 USC 103(a) as obvious over Alberts.

Alberts does not teach determining additional terms related to terms included in said at least one supercategory/categories. Because the chance of identifying the most effective ad for display would increase with the number of terms, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to determine additional terms. Clearly, to be useful, these additional terms would have to be related to terms included in said at least one supercategory/categories.

Allowable Subject Matter

10. Claims 13, 14, 22 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
11. The following is an examiner's statement of reasons for the indication of allowable subject matter: The closest prior art, Alberts, does not teach or suggest forming a banner ad term list. Smith et al. does teach a term list (*object identifier field*, col. 10 line 37), which would

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read on a banner ad term list if this teaching were combined with Alberts. The prior art does not suggest this combination.

12. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Outstanding Issues and Examiner's Discussion

13. Applicants' arguments filed 11 June 2001 (Paper No. 8) have been fully considered but they are not persuasive.
14. **ISSUES** – The essential issue is whether Alpert discloses or suggests associating at least one supercategory with multiple categories. The rejection (paragraph 5) is based on an inherent association.

15. EXAMINER'S DISCUSSION OF THE ISSUES –

(A) Examiner could not find an explanation in the specification for associating supercategories with categories. The specification amply explains mapping categories to supercategories (beginning at p. 141 line 19), but does not provide a basis for concluding that associating means mapping. In such a case, examiner is required to use the broadest reasonable interpretation of "associating" (MPEP§ 2111). That is "to join together" (Webster's Collegiate), including in intangible ways. This is its common meaning in the advertising art (see, for example, Sterne).


(B) As to the rejection, applicant has admitted by example in claim 12 that a geographic area is a supercategory, and the reference teaches two categories, skiing and photography, which are inherently associated with the supercategory, using the broad sense of the term "associated", which is the sense commonly used in the advertising art.

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Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
17. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Champagne whose telephone number is (703)308-3331. The examiner's normal work schedule is 6:30 AM to 5 PM ET Monday through Thursday.

DLC
23 August 2001


ERIC W. STAMBER
PRIMARY EXAMINER